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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
KARIKARI, KWASI	

ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/627,053	CHANG, JIUN-BEI	
	Examiner	Art Unit	
	Kwasi Karikari	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12/23/06*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 7 is/are pending in the application.

4a) Of the above claim(s) *1-6* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-6 have been cancelled.

2. The indicated allowability of claim 7 is withdrawn in view of the newly discovered reference(s) to claim 7. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant uses claimed limitations: "on the other hand", "said 3G mobile phone for proceeding a voice output processing", "and furthermore", and "said power switch immediately has an ability". These limitations are not clearly presented in the Specification, thus, hampering one of ordinary skill in the art to clearly interpret the Applicant's claimed language.

Claim 7 also recited the claimed limitations "wherein an external sound received by said microphone of said external video/audio...an echo", "wherein a voice signal received from an antennal terminal of said 3G mobile phone...said 3G mobile phone", and "wherein after said plug... said 3G mobile phone". The use of a transitional clause

"wherein" or whereby, followed by a method claim limits the claim to a particular structure; i.e., "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited". The "wherein" clauses are replete with functional language that fails to contribute to the structure of the claimed "guide and guard device".

Therefore all the claimed limitations (indicated as **[[ ]]**) followed by a "wherein" clause in a particular paragraph, will not be given weight because the claimed limitations are simply expressing the intended result of the device claim.

See MPEP 2111.04 [R-3] as follow:

"Adapted to," "Adapted for," "Wherein," and "Whereby" Clauses

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

(A) " adapted to " or "adapted for " clauses;

(B) " wherein " clauses; and

(C) " whereby " clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In Hoffer v. Microsoft Corp., 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change

the substance of the invention." Id. However, the court noted (quoting Minton v. Nat 'l Ass 'n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited".

Appropriate corrections are needed for the entire claimed language, especially to specifically point out what the claimed invention is. Thus, either the claimed invention is a 3G mobile terminal or a portable guide and guard mini-camera.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 recites the claimed limitations "through said power/signal line" and "said plug" There are insufficient antecedent basis for these limitations in the claim. Proper corrections are required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kansakoski et al. (U.S. 6,377,813), (hereinafter Kansakoski), in view of Brady (U.S. 6,390,845), (hereinafter Brady), and further in view of Heiman (U.S. 20020085111 A1), (hereinafter Heiman), and further in view of Hollstrom et al., (U.S. 20050009561 A1), (hereinafter Hollstrom).

Regarding **Claim 7**, Kansakoski discloses a separate portable guide and guard device for coupling to a portable guide and guard system (cellular network including base station 30, and a mobile switch center 34, see col. 5, lines 39-54 and Figs. 1 and 2), (which reads on the portable guide and guard system) comprising a 3G mobile phone (mobile station 10, see col. 5, line 67- col. 6, line 3 and Fig. 2) and an external video/audio input/output device (see Heiman's digital camera 12 (which reads on the "external video/audio input/output and mini-camera") in Fig. 1-4,), wherein said 3G mobile phone comprises:

1) a central processing unit (see controller 18) for processing all signals, data and control instructions (the operations of the controller 18, see col. 7, lines 13-19);

2) a sound gathering unit having an external microphone accessory and a sound gathering element (see col. 7, lines 1-12), wherein **[[**an external sound received by said microphone of said external video/audio input/output device is inputted into said sound gathering element of said 3G mobile phone through said power/signal line and, on the other hand, a voice from said external microphone accessory is transmitted to said central processing unit of said 3G mobile phone for proceeding a voice output

processing, and furthermore, said sound gathering element has an ability of echo elimination which is initiated when said microphone of said video/audio input/output device and said external microphone accessory of said 3G mobile phone are simultaneously operated so as to reduce an echo]];

3) a sound broadcasting unit having an external earphone accessory and a broadcasting element (see col. 7, lines 1-12), [[wherein a voice signal received from an antennal terminal of said 3G mobile phone is processed by said broadcasting element and then transmitted to said speaker of said external video/audio input/output device through said power/signal line for broadcasting said voice and, on the other hand, a voice from a service center is received through said external earphone of said 3G mobile phone]];

4) an antennal terminal (12) for emitting and receiving a wireless electromagnetic wave;

5) a power unit for supplying all power demand (mobile phone includes a battery 26 for powering the various circuits that are required to operate the mobile station (see col. 7, lines 10-12),

Kansakoski fails to teach: 6) a power switch, [[wherein after said plug of said power/signal line of said external video/audio input/output device is plugged into a socket of said 3G mobile phone, said power switch immediately has an ability to initiate a power supply, and then said external video/audio input/output device is synchronous to an operation of said power switch of said 3G mobile phone]];

7) a function of power on/off said portable guide and guard, [[wherein after

said plug of said power/signal line of said external video/audio input/output device is plugged into said socket of said 3G mobile phone, said portable guide and guard function is initiated/shut down through pressing a confirm button of said 3G mobile phone]],

8) a function of speaker mute which is initiated/shut down through choosing a mute sub-selection in a menu of portable guide and guard of said 3G mobile phone;

9) a volume regulating button for also controlling a volume of said speaker of said external video/audio input/output device;

10) an earphone/microphone socket for externally connecting an earphone/microphone accessory to obtain a sound gathering function from said microphone and a sound broadcasting function from said earphone and

an external video/audio input/output device, wherein said external video/audio input/output device comprises a mini-camera, a microphone, a speaker, a power/signal line and a plug thereof for connecting to said 3G mobile phone and an emergency calling button.

Brady teaches a portable radio 10 that includes a power switch (a combination volume control and on/off power switch 18, see col. 4, lines 58-67), [[wherein after said plug of said power/signal line of said external video/audio input/output device is plugged into a socket of said 3G mobile phone, said power switch immediately has an ability to initiate a power supply, and then said external video/audio input/output device is synchronous to an operation of said power switch of said 3G mobile phone]];

7) a function of power on/off (a combination volume control and on/off power switch 18, see col. 4, lines 58-67) said portable guide and guard, **[[**wherein after said plug of said power/signal line of said external video/audio input/output device is plugged into said socket of said 3G mobile phone, said portable guide and guard function is initiated/shut down through pressing a confirm button of said 3G mobile phone**]]**,

8) a function of speaker mute (a combination volume control and on/off power switch 18, see col. 4, lines 58-67) which is initiated/shut down through choosing a mute sub-selection in a menu of portable guide and guard of said 3G mobile phone;

9) a volume regulating button (a combination volume control and on/off power switch 18, see col. 4, lines 58-67) for also controlling a volume of said speaker of said external video/audio input/output device;

10) an earphone/microphone socket (multi-point connector 30, see col. 5, lines 16-34) and an emergency button 20 (see col. 4, lines 58-67)

The combination of Kansakoski and Brady fail to teach an external video/audio input/output device, wherein said external video/audio input/output device comprises a mini-camera, a microphone, a speaker, a power/signal line and a plug.

Heiman discloses a method of apparatus for providing traveling information (see Par. [0032]). Heiman further teaches that apparatus includes a digital camera 12 (which reads on the "external video/audio input/output and mini-camera"), a speaker 29 (see Figs. 1-4),

However the combination of Kansakoski, Brady and Heiman fail to teach a connection between the external video/audio input/output device and the 3G mobile phone via a power/signal line and a plug.

Hollstrom's teaching of the connection between external utility device 50 and the mobile telephone 1 via external interface 52 (see Pars. [0025-26] and Fig. 1), meets the limitation of connecting the video/audio input/output device and the 3G mobile phone via a power/signal line and a plug.

Since as discussed above, the "wherein " clauses do not contribute to the structure of the invention as claimed, what remains is a combination of old and well-known element. Therefore, it would therefore have been obvious to one of the ordinary skill in the art to combine Kansakoski, Brady, Heiman and Hollstrom for the benefit of achieving a system that could capture images and transmit it to a processing center.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ketcham (U.S. 6,075,860) discloses an apparatus and method for authentication and encryption of a remote terminal over a wireless link.

Reele et al., (U.S. 5,893,037) teaches a combined electronic /silver-halide image capture system with cellular transmission capability

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kwasi Karikari whose telephone number is 571-272-8566. The examiner can normally be reached on M-F (8 am - 4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8566.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kwasi Karikari
Patent Examiner.

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER